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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/012,272	01/23/98	LEE S	028870-080

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EXAMINER	
PAK, J	
ART UNIT	**PAPER NUMBER**
1616	19

DATE MAILED: 03/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/012,272	LEE et al.
Examiner	**Group Art Unit**
John Pak	1616

☒ Responsive to communication(s) filed on *Feb 21, 2001* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-4, 6, 8, and 9* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-4, 6, 8, and 9* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

This Office Action is in reply to applicant's After-Final response of 2/21/01. Applicant is advised that the Finality of the Office Action of 11/22/00 is hereby withdrawn. All previous grounds of rejection and all previous indication of allowable subject matter are hereby withdrawn.

Applicant is advised of the following claim suggestions:

Claim 1, line 2: delete "topical application" and insert --- topically applying --- .

Reason: improved language for a positive action taking step for a method claim.

Claim 6, line 2: delete "a composition, by weight percentages as follows" and insert --- the following compositional weight percentages --- .

Reason: same language as claim 1 and avoids the awkward phrase "composition .. has a composition ..."

Claim Rejection -- 35 USC 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenspan et al. (US 5,834,008) in view of Litkowski et al. (US 6,086,374).

Greenspan et al. teach bioactive glass for treating wounds, burns and for grafting skin. See claims 9-12; column 5, lines 32-62. The preferred particle size range for the bioactive glass is

less than 90 microns (column 5, lines 26-29). Bacteriostatic effect of bioactive glass is disclosed (paragraph bridging columns 5 and 6).

Litkowski et al. disclose that bioactive glass is known to have bacteriostatic or bacteriocidal effect, due to pH change induced by dissolution of ions from the surface of the glass and lack of bacterial adherence to the glass surface (column 2, lines 42-47).

Applicant's claims are directed to treating "inflammatory symptoms related to skin disorders, other than wounds," and the skin conditions disclosed by Greenspan et al. such as burns and skin graft sites read on applicant's claim scope. It is common knowledge that inflammations occur at burn and skin graft sites; and therefore, Greenspan's process of administering bioactive glass to such sites would necessarily reduce inflammation since the very same bioactive glass is topically applied to the very same treatment sites.

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been fairly suggested by the combined teachings of the references.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6 and 8-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-12 of U.S. Patent No. 5,583,008 in view of Litkowski et al.

The same rationale is applicable here as that set forth above in the ground of rejection under section 103(a), and discussion and rationale therefrom are incorporated herein to avoid repetition.

For these reasons, all claims must be refused again.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Pak whose telephone number is (703) 308-4538. The Examiner can normally be reached on Monday through Thursday from 8:00 AM to 5:30 PM. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JOHN PAK
PRIMARY EXAMINER
GROUP 1600